

The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

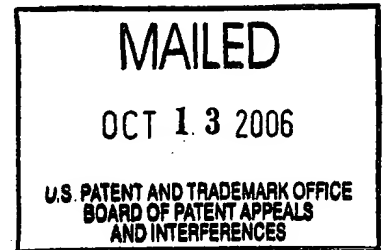
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte SHANKAR SAHAI, and DANIEL DANTE LORENZO

Appeal No. 2006-2506
Application No. 09/614,867

ON BRIEF



Before KRASS, BARRY, and HOMERE, ***Administrative Patent Judges.***

HOMERE, ***Administrative Patent Judge.***

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the final rejection of claims 1 through 18, all of which are pending in this application.

We reverse.

Invention

Appellants' invention relates generally to a method, a system and a computer program product for redirecting a user from a second website to a first website. The disclosed website redirection is accomplished through the use of client and server side programs that share access and management of cookies in user's computer. Initially, the second website displays on the user's browser a URL that offers a product or a service to the user. Upon the user activating the URL, a program that underlies the URL reads a cookie located in the user's computer to determine whether the user's computer already possesses the offered product or service. If the program determines that the user's computer already possesses the offered product or service, then the user is redirected to the first website. If, however, the program determines that the user's computer does not possess the offered product or service, then the second website offers to supply said product or service to the user.

Claim 1 is representative of the claimed invention and is reproduced as follows:

1. A method for redirecting a user from a second Web site to a first Web site, comprising the steps of:

(1) providing, by the second Web site, a URL offering a product or service to the user, said URL specifying a program on the second Web site;

(2) reading, by said program, a cookie located in the user's computer in response to the user activating said URL;

(3) providing a positive determination when an inquiry by said program, from said cookie as to whether the user already possesses said product or service is true;

(4) redirecting, by said program, the user to the first Web site when the determination of step (3) is positive determination, wherein the first Web site is specified by said cookie; and

(5) offering, by the second Web site, to supply said product or service to the user when the determination of step (3) is negative;

whereby the user who already possesses said product or service will not receive duplicate offers to supply said product or service from multiple Web sites.

REFERENCES

The Examiner relies on the following references:

1. Persistent Client State HTTP Cookies- Preliminary Specification

http://wp.setscape.com/newsref/std/cookie_spec

2. AOL Webmaster.Info-About Cookies

<http://webmaster.info.aol.com/aboutcookies>

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Rejections At Issue

A. Claims 1 through 18 stand rejected under 35 U.S.C. § 112, first paragraph as failing to comply with the enablement requirement.

B. Claim 1 stands rejected under 35 U.S.C. § 112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which the applicant regards as the invention.

Rather than reiterate the arguments of Appellants and the Examiner, the opinion refers to respective details in the Briefs¹ and the Examiner's Answer². Only those arguments actually made by Appellants have been considered in this decision. Arguments that Appellants could have made but chose not to make in the Briefs have not been taken into consideration. See 37 CFR 41.37(c)(1)(vii)(eff. Sept. 13, 2004).

¹ Appellants filed an Appeal Brief on June 6, 2005. Appellants filed a Reply Brief on Nov. 25, 2005.

² The Examiner mailed an Examiner's Answer on Sep. 21, 2005. The Examiner mailed an office communication on Mar. 27, 2006 stating that the Reply Brief has been entered and considered.

OPINION

In reaching our decision in this appeal, we have carefully considered the subject matter on appeal, the Examiner's rejections, the arguments in support of the rejections and the evidence of lack of enablement and indefiniteness relied upon by the Examiner as support for the rejections. We have, likewise, reviewed and taken into consideration Appellants' arguments set forth in the Briefs along with the Examiner's rationale in support of the rejections and arguments in the rebuttal set forth in the Examiner's Answer.

After full consideration of the record before us, we do not agree with the Examiner that claims 1 through 18 are properly rejected under 35 U.S.C. § 112, first paragraph as failing to comply with the enablement requirement. We also do not agree with the Examiner that claim 1 is properly rejected under 35 U.S.C. § 112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which Appellants regard as the invention. Accordingly, we reverse the Examiner's rejections of claims 1 through 18 for the reasons set forth *infra*.

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I. Under 35 U.S.C. § 112, First Paragraph, is the Rejection of Claims 1 through 18 as Failing to Comply with the Enablement Requirement Proper?

With respect to representative claim 1, Appellants argue that the Examiner has not properly established a prima facie case showing that the claims do not comply with the enablement requirement. Particularly, Appellants argue that the Examiner has failed to establish a reasonable basis to question whether Appellants' disclosure, taken as a whole, is adequately enabling of the claim limitation whereby a first and second web sites can share access of cookies in a user's computer through client and server side programs.

As a matter of Patent and Trademark Office practice, the Examiner bears the initial burden of establishing a prima facie case for showing that the claimed subject matter is not enabled. A disclosure which contains a teaching of the manner and process of making the invention, and which contains a scope commensurate with those used to describe and define the subject matter sought to be patented must be taken as in compliance with the enabling requirement of the first paragraph under 35 U.S.C. § 112 unless there is reason to doubt the objective truth of the statements contained therein which must be relied on for enabling support.

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Assuming that sufficient reason for such doubt does exist, a rejection for failure to teach how to make and/or use will be proper on that basis. Such a rejection can be overcome by suitable proofs indicating that the teaching contained in the specification is truly enabling, *In re Marzocchi*, 439 F.2d, 220, 223, 169 USPQ 367, 369 (CCPA 1971); *In re Sichert*, 566 F.2d 1154, 1162, 196 USPQ 209, 216 (CCPA 1977).

In this case, the Examiner has taken the position that Appellants' specification fails to detail the specific steps that the second website's program must take in order to read the cookie stored in the user's computer and to determine the content of the cookie. Further, the Examiner relies on a number of articles to support the position that "[a] cookie can only be read and modified by an object in the valid domain and path defined in the cookie when it was created". Additionally, the Examiner presented other references as evidence that the notion of inter-domain cookie access and the sharing of cookies between websites are not recommended as such implementations would jeopardize user's privacy, and would lead to various security breaches.

With the above discussion in mind, we find that the Examiner has not provided sufficient evidence to show that the claimed invention is not enabling. Particularly, as rightfully noted by Appellants, the Examiner's position is predicated upon the fact that traditional web browsers do not allow inter-domain cookie access and the sharing of cookies between the websites. The evidence of record merely indicates that such sharing of access to user's computer by another website, which is not in the creation path of the cookie is not supported by traditional browsers, and that such shared access of cookies, if implemented could render the user's computer vulnerable to security threats. However, none of the evidence of record actually shows that the implementation of inter-domain cookie access and the sharing of cookies between websites cannot be, in fact, accomplished through the use of client and server side programs. Further, our review of Appellants' specification reveals no such lack of details pertaining to the accomplishment of the claimed inter-domain access of a cookie in the user's computer and the redirection of the user from a website to another. See page 7, lines 8 through 28, page 11, lines 14 through 27 and page 12, lines 1 through 19 of Appellants' specification. Additionally, in assessing enablement of a claim or the lack thereof, Office policy requires that the Examiner apply

the factors set forth in *In re Wands*, 858 F.2d 731, 737, 8 USPQ2d 1400, 1404 (Fed. Cir. 1998). See also MPEP § 2164.01(a) and 2164.04. We find no such application of the factors in the Examiner's rejection. Thus, we agree with Appellants that the Examiner has not properly established a prima facie case for lack of enablement. Consequently, we find error in the Examiner's stated position, which concludes that claims 1 through 18 do not comply with the enablement requirement. It is therefore our view, after consideration of the record before us, that the evidence relied upon and the level of skill in the particular art would not have suggested to the ordinarily skilled artisan that the invention as set forth in claims 1 through 18 is not enabled. Accordingly, we will reverse the Examiner's rejection of claims 1 through 18 under 35 U.S.C. § 112, first paragraph.

II. Under 35 U.S.C. § 112, Second Paragraph, is the Rejection of Claim 1 as being Indefinite for Failing to Particularly Point out and Distinctly Claim the Subject Matter which Appellants Regard as the Invention Proper?

With regard to claim 1, Appellants argue that the limitation of a positive or a negative determination from a cookie indicating whether or not the user possesses a product or service is not indefinite.

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Under current Office policy, the Examiner bears the initial burden of making a prima facie case for indefiniteness under 35 U.S.C. § 112, second paragraph. In doing so, the Examiner must inquire whether the claims do, in fact, set out and circumscribe a particular area with a reasonable degree of precision and particularity. The definiteness of the language in the claims must be analyzed, not in a vacuum, rather in light of the teachings of the prior art and of the particular application disclosure as it would be interpreted by one of ordinary skill in the pertinent art. *In re Moore*, 439 F.2d 1232, 1235, 169 USPQ 236, 238 (CCPA 1971). The Examiner must thus determine whether Appellants' claims, interpreted in light of the disclosure, reasonably apprise the ordinarily skilled artisan of the invention.

In this case, the Examiner's assertion that the terms "positive" and "negative" are murky is untenable. One of ordinary skill would readily recognize that the terms in question must be given their ordinary meaning. In addition, the ordinarily skilled artisan, having read Appellants' disclosure, would be readily apprised that the limitation of a positive determination from a cookie indicating whether the user possesses a product or service


means that if the program determines that the cookie on the user's computer does already possess the offered product or service, then the program will automatically redirect the user to the first web site. Similarly, the ordinarily skilled artisan would be readily apprised of the fact that the limitation of a negative determination from a cookie indicating whether the user possesses a product or service means that if the program determines that the cookie on the user's computer does not already possess the offered product or service, then the program will ask whether the user wants to sign up for such product or services. Consequently, we find error in the Examiner's stated position, which concludes that claim 1 is indefinite for failing to particularly point out and distinctly claim the subject matter, which Appellants regard as the invention. It is therefore our view, after consideration of the record before us, that the evidence relied upon and the level of skill in the particular art would not have suggested to the ordinarily skilled artisan that the invention as set forth in claims 1 is indefinite. Accordingly, we will reverse the Examiner's rejection of claim 1 under 35 U.S.C. § 112, second paragraph.

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CONCLUSION

In view of the foregoing discussion, we have not sustained the Examiner's decision rejecting claims 1 through 18 under 35 U.S.C. § 112, first paragraph. We have also not sustained the Examiner's rejection of claim 1 under U.S.C. § 112, second paragraph. Therefore, we reverse.

REVERSED


ERROL A. KRASS
~~Administrative Patent Judge~~

LANCE LEONARD BARRY
Administrative Patent Judge

BOARD OF PATENT
APPEALS AND
INTERFERENCES

Jean R. Homere
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